

REMARKS

This is a full and timely response to the outstanding Office action mailed April 21, 2004. Upon entry of the amendments in this response claims 1-20 and 22-35 are pending. More specifically, claims 1, 16, 29 and 34 are amended and claim 21 is canceled. These amendments are specifically described hereinafter. It is believed that the foregoing amendments add no new matter to the present application.

I. Present Status of Patent Application

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-3, 6-10, 12 and 14 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Otorii*, (U.S. Patent No. 5,632,018) further in view of *Nakashima et al* (U.S. Patent No. 6,470,385). Claim 4 is rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Otorii* and *Nakashima* further in view of *Chuah et al* (U.S. Patent No. 6,400,722). Claim 5 is rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Otorii* and *Nakashima* further in view of *Kozdon et al* (U.S. Patent No. 6,456,601). Claims 13 and 20 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Otorii* and *Nakashima* further in view of *Bookspan et al* (U.S. Patent No. 6,636,888). Claim 15 is rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Otorii* and *Nakashima* further in view of *Lewis* (U.S. Patent No. 6,513,019). Claim 28 is rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Otorii* and *Nakashima* further in view of *Ooe* (U.S. Patent No. 6,330,238). Claims 10, 16-19, 21-27, and 29-35 allegedly do not teach or define any new limitations above claims 1-9, 11-15, 20 and 28 and therefore are rejected for similar reasons.

II. Examiner Interview

Applicant first wishes to express his sincere appreciation for the time that Examiners Avi Gold, and Saleh Najjan spent with Applicant's Attorneys during a July 19, 2004 telephone discussion regarding the above-identified Office Action. Applicant believes that certain important issues concerning the format of the broadcast message not disclosed in *Otorii* or

Nakashima were identified during the telephone discussion, and that they are resolved herein. During that conversation, Examiners Gold and Najjan seemed to indicate that it would be potentially beneficial for Applicant to file these amendments and response. Thus, Applicant respectfully requests that Examiner Gold carefully consider these amendments and response.

III. Miscellaneous Issues

The Office Action states that claims 10, 16-19, 21-27, and 29-35 do not teach or define any new limitations above claims 1-9, 11-15, 20, and 28 and therefore are rejected for similar reasons. Claims 10, 16-19, 21-27, and 29-35 use different language from claims 1-9, 11-15, 20 and 28, have different combinations of elements and should be analyzed separately for patentability. Consequently, Applicant traverses such a statement and suggests that such a grouping without support is improper.

IV. Rejection Under 35 U.S.C. §112 second paragraph

Claim 3 is rejected as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. However, no further explanation was offered as to why the claim fails to comply with §112, second paragraph. According to M.P.E.P §2171, "If a rejection is based on 35 U.S.C. §112, second paragraph, the Examiner should further explain whether the rejection is based on indefiniteness or on failure to claim what applicant regard as their invention. Ex parte *Ionescu*, 222 USPQ 537, 539 (Bd. App. 1984). Since much of the language in claim 3 is also contained in other claims, Applicant has not been able to ascertain the reasoning behind the rejection. For these reasons, Applicant respectfully traverses the rejection and maintains that the next Office Action should be non-final.

V. Rejections Under 35 U.S.C. §103(a)

A. Claims 1, 16, 29 and 34

The Office Action rejects claims 1, 16, 29, and 34 under 35 U.S.C. §103(a) as being unpatentable over *Otorii* (U.S. Patent No. 5,632,018) further in view of *Nakashima et al.*, (U.S.

Patent No. 6,470,385). For the reasons set forth below, Applicant respectfully traverses the rejection. Each claim has a different combination of elements, which distinguish each claim from the prior art of record. Consequently, each claim should be analyzed separately for patentability.

Independent claim 1 recites:

A method for sending electronic mail from a client operating within a client-server architecture, the method comprising the steps of:

- (a) provisioning the client with client broadcast messaging software;
- (b) provisioning a server with server broadcast messaging software, wherein the server is in communication with the client;
- (c) ***broadcasting from the client a message in a format of the broadcast messaging software, wherein the message contains the electronic mail;***
- (d) receiving the message at the server;
- (e) ***reformatting the message from a format of the broadcast messaging software to a format compatible with an email server;*** and
- (f) forwarding the reformatted message to the email server.

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical.*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988) and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Applicant respectfully submits that independent claim 1 is allowable for at least the reason that *Otorii* and *Nakashima* do not disclose, teach, or suggest at least **broadcasting from the client a message in a format of the broadcast messaging software, wherein the message contains the electronic mail, and reformatting the message from a format of the broadcast messaging software to a format compatible with an email server.**

The Office Action claims that *Otorii* teaches provisioning the client with client broadcast messaging software: “*Otorii* discloses a client broadcasting email.” *See Otorii*, col. 3, lines 51-65. However, broadcast messaging software is not email software that broadcasts. It has a

fundamentally different structure. This is corroborated in the claim itself as the format of the broadcast message is reformatted to be compatible with the email server.

Additionally, *Nakashima* discloses nothing about converting broadcast messages to email messages. It only discloses the conversion of a message. Therefore, *Nakashima* does not disclose converting broadcast messages to email messages, nor is it obvious to do so. To make the assertion that it is obvious would be averring that *Nakashima* makes the conversion between any two message types obvious. It simply does not.

Applicant also respectfully disagrees that there is motivation to combine the *Otorii* and *Nakashima* references. There must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements as claimed by the Applicant. Neither the *Otorii* or *Nakashima* reference do so.

Additionally, it appears that the combination has been made using hindsight. "It is impermissible ... simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps." In re Gorman, 933 F.2d 982, 987, 18 U.S.P.Q.2d 1885 (Fed. Cir. 1991).

"(T)here must be some reason for the combination other than the hindsight gleaned from the invention itself." Interconnect Planning Corp. v. Feil, 774 P.2d 1132, 1143, 227 U.S.P.Q. 543 (Fed. Cir. 1985). It appears that, after viewing the elements of the claims, some of the elements were found in one reference and some in another. Those references were combined using only the hindsight and inventive aspects revealed by the disclosure and claims of the application. Therefore, it appears that hindsight has been used in this combination and the rejection is invalid.

As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of the independent claims. Notwithstanding, the undersigned has reviewed the entirety of the *Otorii* and *Nakashima* patents, and has failed to

identify any such teaching anywhere within these references. Therefore, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons the independent claims are allowable.

B. Claims 2-15, 17-28, 30-33, and 35

Because the independent claims are allowable over the prior art of record, the corresponding dependent claims (which depend from the independent claims) are allowable as a matter of law for at least the reason that the dependent claims contain all the steps/features of the independent claims. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, the rejection to the dependent claims should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of the independent claims, the dependent claims recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the prior art of record. Hence there are other reasons why the dependent claims are allowable.

VI. Prior References Made of Record

The prior references made of record have been considered, but are not believed to affect the patentability of the presently pending claims. Other statements not explicitly addressed herein are not admitted.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1-20 & 22-35 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,



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